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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,089	07/10/2001	Rick Rowe	IGTECH.0018P	1158

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EXAMINER
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SAGER, MARK ALAN

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 11/20/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.  
**09/903,089**

Applicant(s)  
**Rowe et al**

Examiner  
**Sager**

Art Unit  
**3714**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/25/2001, 12/24/2002
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2-3                      6) ☐ Other:

***Restriction Requirement***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1-5, 10-20, drawn to method or gaming system generating a receipt redeemable for an award, classified in class 463, subclass 26.
  - II. Claim 6-9, drawn to method for generating a receipt regarding operational characteristics, classified in class 463, subclass 30.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as method or gaming system for generating a receipt for redemption of an award not requiring the features/steps of invention II; while, invention II has separate utility as a method for generating a receipt of operational characteristics not requiring the features/steps of invention I. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. R. S. Weide (37755) on 11/9/2003 a provisional election was made without traverse to prosecute the invention of Group I, claim 1-5, 10-20. Affirmation of this election must be made by applicant in replying to this Office action. Claim 6-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Counsel consented to withdraw of cited claims.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 19 recites "said award" in line 8. Essentially, it is unclear from language as to which award this refers.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

9. Claim 1-3, 10-14, 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Applicants' admitted prior art cited in instant application. Regarding claim interpretation, receipt is defined by Webster's II New Riverside University Dictionary © 1994, as a) an act of receiving something or b) the amount or quantity received; while, generating is defined therein as producing or bringing into existence. Thus, the breadth of claim language includes producing (including transmitting) a signal of a value or amount of play, i.e. game activity, related to player tracking at gaming machine. Instant application discloses a method for crediting a player of an electronic gaming device in a gaming system teaching all claimed steps/features including at least one gaming machine adapted to accept credit present a game and pay a winning in the event a winning event is achieved by play of the game, at least one host with which at least one gaming machine is associated arranged to receive play information regarding player play of machine to determine if an award should be issued for play independent of a winning outcome, transmitting award information to gaming machine and a receipt generator located at gaming machine for issuing a receipt associated with said award in response to reward information being transmitted to gaming machine from at least one host, generating data regarding player's activity (page 1), determining if player is entitled to an award... independent of the direct outcome of a specific game or games (page 1), generating a receipt at gaming machine for redemption by player for award (page 1) wherein the player's play produces points based on play according to one or more predetermined levels for cashing-in, i.e. redeeming, the accumulated points for comp prizes such as free games, dinner or show. Acres, 6371852, (5:25-31) which was filed in 1998, is further submitted as

evidence that claimed method/system was known in use at least one year prior to filing of instant invention and thus constitutes a bar under section 102, as broadly claimed.

10. Claim 1-3, 10-12-14, 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Acres (6371852). Claim interpretation presented above is incorporated herein. Acres ('852) incorporates assignee reference (5752882, 6244958, 6319125) in their entirety for all purposes. Acres ('852) discloses a method for crediting a player of a gaming device in a system teaching all claimed steps/features including at least one gaming machine adapted to accept credit present a game and pay a winning in the event a winning event is achieved by play of the game, at least one host with which at least one gaming machine is associated arranged to receive play information regarding player play of machine to determine if an award should be issued for play independent of a winning outcome, transmitting award information to gaming machine and a receipt generator located at gaming machine for issuing a receipt associated with said award in response to reward information being transmitted to gaming machine from at least one host, generating data regarding player's activity (1:15-62, 2:37-59, 3:55-4:25, 5:1-25), determining if player is entitled to an award... independent of the direct outcome of a specific game or games (5:1-10:16, esp. 8:60-64), generating a receipt at gaming machine for redemption by player for award (5:1-10:16, esp. 8:60-9:51) where the award is accumulable account points based on wagered play and redeemable as conversion from account points to account credits for 'free' game play.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claim 4-5, 15-19, is rejected under 35 U.S.C. 103(a) as being unpatentable over either Applicants' admitted prior art or Acres ('852) each in view of Burns (6048269) or Kelly (5816918). Applicants' admitted prior art or Acres each discloses a method in a system comprising claimed steps/features (supra) except print a receipt (clms 4-5, 15). First, it is noted that Applicants' admitted prior art or Acres is equivalent to claimed invention for generating a receipt in form of producing a value or number of points representing players play activity independent of gaming outcome for a game or games for redemption for a prize such as a free game. The difference between these steps/features and that which is clearly taught by Applicants' admitted prior art or Acres lie in the form of receipt issued. As these features/steps are variations of issuing receipts as are known, such would have been obvious to one of ordinary skill in the art in implementation of Applicants' admitted prior art or Acres. Absent criticality, specific form of

receipt fall within the realm of choice by game designers, when implementing a particular form of receipt onto Applicants admitted prior art or Acres. The lack of criticality of the specific recitations in the claims is evidenced by Applicant's disclosure which further teaches these variations to be equivalent choices. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add 'print a receipt' as an equivalent form of receipt to Applicants' admitted prior art or Acres method/system in order to encourage the issue a tangible form of play activity for redemption. Further, Burns (5:46-6:67, 7:61-67) or Kelly (8:38-11:34) each disclose method or system teaching producing printed ticket or coupon as an equivalent form of issuing a recordation of play to producing an electronic recordation. Therefore, it would have been obvious to an artisan at a time prior to the invention to add print a receipt as taught by either Burns or Kelly to Applicants admitted prior art or Acres method/system to produce a paper ticket usable for redemption of points earned for a prize.

#### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. S. Tom Hughes, can be reached on (703) 308-1806. The fax phone number for this Group is (703) 872-9306. Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0858; while, *any inquiry relating to the status of this application or proceeding should be directed to 3700 Customer Service at 703/306-5648.*



M. Sager  
Primary Examiner  
Nov 13, 2003